

REMARKS

Claims 1, 3, 6-11, and 13-21 remain pending in this application. Claim 12 has been canceled. Claim 11 has been amended.

I. § 112 REJECTION

Claim 11 has been amended so that it has proper antecedent basis. Applicant submits that claim 11 as amended is definite.

II. § 103 REJECTION

Applicant submits that the pending claims are novel and non-obvious over the cited references. As admitted in the Office Action, neither App. No. PCT/GB97/01222 (International Publication No. WO 98/50045) (hereinafter "the PCT application") nor U.S. Pat. No. 5,843,980 to Hall et al. (hereinafter "Hall") disclose or suggest a formulation that includes an antibiotic from the florfenicol class of compounds, such as florfenicol or chloramfenicol.

In fact, the PCT application teaches away from the present invention by listing a number of common classes of antimicrobials with the **exception** of the florfenicol class of compounds. This absence seems to suggest that any unlisted antimicrobials used in the formulation should be selected from one of the listed classes of compounds and not the florfenicol class of compounds.

A person having ordinary skill in the art would not have been motivated to substitute florfenicol or chloramfenicol for the antimicrobial compound used in the composition disclosed in the PCT application by the statement "other antimicrobials may also be usefully employed" in

view of the obvious absence of any suggestion to use the florfenicol class of compounds as antimicrobials.

The advantage of using the florfenicol class of compounds in Applicant's formulation is that this class of compounds is more efficacious in treating upper respiratory infections in cattle than any of the antimicrobials suggested by the PCT application.

Even if Hall and the PCT application are combined, they do not disclose or suggest a formulation containing florfenicol or chloramphenicol. The Patent and Trademark Office's burden of establishing a *prima facie* case of obviousness is not met unless "the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." In re Bell, 26 U.S.P.Q. 2d 1529, 1531 (Fed. Cir. 1993)(quoting In re Rinehart, 189 U.S.P.Q. 143,147 (C.C.P.A. 1976)). Applicant submits that a *prima facie* case of obviousness for rejecting the pending claims is not established with these references.

The PCT Publication and Hall do not disclose or suggest compounds of a sufficiently similar structure to the florfenicol class of compounds to render Applicant's claims obvious. In fact, the florfenicol class of compounds function and interact in an entirely different way from the antimicrobial compounds disclosed by the cited references. See In re Jones, 958 F.2d 347, 350 (Fed. Cir. 1992), (Cited reference discloses "the potentially infinite genus of substituted ammonium salts of dicamba, and lists several such salts", but the salt claimed by the Applicant is not specifically disclosed. The Court reasoned that the claimed salt was not sufficiently similar in structure to those specifically disclosed in the cited reference as to render it *prima facie*

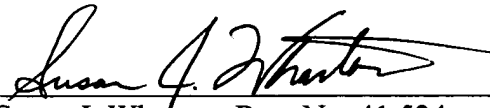
obvious.) The cited references provide no teaching or suggestion that florfenicol or chloramfenicol would be compatible when dissolved in a systemic analgesic formulation.

Corning Glass Works v. Sumitomo Electric U.S.A. Inc., 9 USPQ2d 1962, 1970 (Fed. Cir. 1989) is also analogous to the present situation. In Corning Glass Works, defendant Sumitomo argued “that the use of the term ‘dopant’ in the Japanese publication, together with a listing of polyvalent metal oxide dopants, ‘does not exclude germania.’” The Court reasoned that “[u]nder Sumitomo's theory, a claim to a genus would inherently disclose all species.” The Court went on to state “[w]e find Sumitomo's argument wholly meritless whether considered under section 102(b) or under 35 U.S.C. §103....” For these reasons, Applicant submits that the pending claims are not anticipated or made obvious by the cited references.

III. CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted that the claims are now in condition for allowance and eventual issuance. Such action is respectfully requested. Should the Examiner have any further questions or comments which need be addressed in order to obtain allowance, please contact the undersigned attorney at the number listed below.

Respectfully submitted,

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